

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: :
Jeffrey A. Bedell *et al.* : Group Art Unit: 2194
:
Appln. No. : 09/883,508 :
Filed: June 19, 2001 : Examiner: Li B. Zhen
:
For: SYSTEM AND METHOD FOR :
MANAGING OBJECTS :
BETWEEN PROJECTS :
:

Mail Stop AF
Commissioner for Patents
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REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Pursuant to the Pre-Appeal Brief Conference Pilot Program, Applicants hereby request a pre-appeal brief conference in the above-referenced case.

This application is appropriate for a pre-appeal brief conference. A brief history of this application and why Applicants believe that an appeal will succeed are set forth below.

This application was filed over five years ago on June 19, 2001. On July 6, 2004, an initial office action was issued rejecting the initial claims under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,854,932 to Mariani *et al.* ("Mariani"). In an effort to streamline prosecution, applicants amended independent claim 1 to clarify distinctions.

Despite an attempt to distinguish this application from the cited reference, the Office issued a final office action rejecting the claims under 35 U.S.C. §103(a) over "Mariani" in view of U.S. Patent No. 6,167,563 to Fontana et al. "Fontana" that is certain to be overturned on

appeal. Rather than further time being spent addressing this reference, Applicants have elected to pursue the Pre-Appeal Brief Conference Pilot Program.

As set forth in Applicants' response dated May 3, 2006, the cited reference fails to teach or suggest numerous recitations of the pending claims.

The Office Action alleges that Mariani teaches the invention substantially as claimed with the exception of "automatically identifying dependent objects, automatically causing appropriate functions to be performed on the dependent objects and automatically causing execution of the selected function on the selected object" (Office Action, Page 7) This rejection is hereby respectfully traversed.

First, Mariani does not teach or suggest "determining using a computer processor an appropriate manner of executing the selected function" as recited in claim 1. The Office Action asserts that determining when a function (e.g., recompiling) can be avoided (or not avoided) amounts to determining an "appropriate manner" of performing the function. The word "manner" refers to the way that something is done, not the fact of whether or not it is done. The Examiner, in response to this argument asserts that Mariani's dependency determinations disclose "determin[ing] a particular manner of rebuilding of the executable program." Office Action, page 3. The Applicant notes that "determin[ing] a particular manner of rebuilding of the executable program" is not "determining using a computer processor an appropriate manner of executing the selected function on the selected object." Determining a manner of executing a function is not disclosed by determining the rebuilding of an executable program.

Further, the cited features of Mariani do not collectively teach the elements of claim 1 because they fail to maintain a consistent notion of the recited claim elements (in particular, the

recited nouns such as “selected object”). In other words, the Office Action has not shown a single, coherent embodiment of Mariani that teaches all the elements of the claims. Rather, the Office Action applies disparate features of Mariani that accomplish dissociated tasks. For instance, to teach the “selected function” of claim 1, the Office Action alternately applies “modifying code” to a first element of claim 1 and “recompiling” in subsequent elements. Similarly, to teach a “selected object,” the Office Action appears to apply a “source code file” in the first element of claim 1, an “object code file” in the second element, and specific source code files that were changed since the last project build in the last element. In response to this argument, the Examiner asserts that the recompilation function is a subprocess of the modification function and that the source code files correspond to the identified object code files. Office Action, pages 3-4. However, a subprocess of a function is not the same as the function itself. Thus, if modifying code allegedly disclose “a selected function” in one element, recompilation can not be used to disclose the same “selected function” in subsequent elements. Similarly, if source code files allegedly disclose “a selected object” in one element, the understanding of “a selected object” can not be changed to corresponding object code files or changed source code files in other elements.

Thus, Mariani fails to teach claim 1 as well as claims 10 and 18, which have some related limitations. The same arguments apply to claims 3-5, 11, 12, 16, and 17, which depend from and incorporate the limitations of claims 1 and 10.

The Office Action acknowledges that Mariani does not disclose all the limitations as recited in the claims. As stated on Page 7 of the Office Action, “Mariani does not specifically teach automatically identifying dependent objects, automatically causing appropriate functions to

be performed on the dependent objects and automatically causing execution of the selected function on the selected object.”

Fontana discloses “an inquiry is made as to whether or not the user wants to update dependent components .. if the answer to this inquiry is no, then the components and dependent components [are not updated]” (Fontana Column 7, lines 27-30) Fontana further discloses “[After response to the inquiry] if the user does want to update dependent components [then the components are updated]” (Fontana Column 7, Lines 35-53). Applicant respectfully submits that updating dependent components in response to a user prompt is not the equivalent of the “automatic” elements required by the claims. Fontana thus fails to disclose the missing limitations of Mariani.

Mariani similarly fails to teach or suggest claims 2, 6-9, and 13-15, because claims 2, 6-9, and 13-15 depend from claims 1 and 10 and therefore incorporate the limitations of claims 1 and 10 by reference. Fontana and Almond fail to remedy the deficiencies of Mariani. Thus, the combination of Mariani, Fontana and Almond fails to teach or suggest the elements of claim 2, 6-9, and 13-15.

The Office Action alleges that the meta model disclosed by Almond discloses claim 2.

Applicant respectfully submits that the meta model disclosed by Almond does not teach “the selected object is contained in metadata of an on-line analytical processing system” as required by claim 2. The Examiner responds alleging that a on-line analytical processing system is disclosed by “view reports” functionality. Applicant submits that view reports functionality as disclosed in Almond does not disclose an on-line analytical processing system.

As for claim 6, the Office Action asserts that Mariani as modified by Almond teaches the limitation of receiving a command to copy a selected object from a source project to a destination project. Almond's reference to copying objects fails to teach the subject matter of claim 6 because this feature cannot be combined with Mariani's recompiling in the manner prescribed by claim 6. Thus, the combination of Mariani and Almond does not teach or suggest claim 6.

Clearly, an appeal of this factual question will be resolved in applicant's favor.

For these reasons, Applicants request an appeal conference be convened to advise Applicants whether the Office will 1) allow the present claims, 2) reopen prosecution and issue a new office action or 3) allow this case to proceed to appeal.

Respectfully submitted,



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